



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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8/7/02

In re Application of

JOHANNES-ALBERT MIEDEN

Serial No.: 09/763,356

Art Unit: 3634

Filed: February 21, 2001

Examiner: A. Chin Shue

For: SCAFFOLD COUPLING ELEMENT WITH A SECURE-SITTING HEAD BOLT

RESPONSE

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To the Director of Patents and Trademarks

Sir:

GROUP 3600

In response to the Office Action dated July 2, 2002, kindly consider the following:

Applicant provisionally elects the species of Figure 2, drawn to the t-shaped head, with traverse. Claims 20-34 read on the elected species.

Reconsideration and withdrawal of the election requirement are requested.

The claims of the Figure 2 species and the Figure 9 species do not relate to materially different T-shaped head products. The device defined in relation to figure 2 relates to the T-shaped head, per se, described by claims 35-39 for Figure 9.

They are not related to materially different products that would result in different apparatuses used for different purposes nor can they be used to practice a different invention than that

intended and claimed.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP § 802.01 points out that a sub-combination and a combination are not independent inventions, and that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the species are distinct. That is, as pointed out in MPEP § 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under MPEP § 803 that the claimed inventions:

are able to support separate patents and they are ...
distinct (MPEP § 806.05-806.05(i)).

However, MPEP § 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it

on the merits, even though it includes claims to distinct or independent inventions.

So that § 803 makes its point clearly, the serious burden requirement is repeated under the title:

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

MPEP § 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner.

The Federal Circuit has held that the patent office is obligated to make necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided any reasoning for the arbitrary species election requirement between the claims on record.

Hence, the Examiner should kindly withdraw the restriction and consider all the claims, 20-39.

For the above reasons, the Applicant believes that the claims should be examined together.

Reconsideration and withdrawal of the requirement are respectfully requested.

Since Applicant has presented a novel, unique and non-obvious invention, reconsideration and allowance are respectfully requested.

Respectfully,



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